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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,799	09/10/2003	Seong-Jin Moon	1101.0109	1813

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North Star Intellectual Property Law, PC
P.O. Box 34688
Washington DC, DC 20043

EXAMINER	
TOPGYAL, GELEK W	

ART UNIT	PAPER NUMBER
2621	

MAIL DATE	DELIVERY MODE
02/19/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/658,799	MOON ET AL.	
	Examiner	Art Unit	
	GELEK TOPGYAL	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 December 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1,2,4,5 and 42-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,5 and 42-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application.
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/7/2009 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claims 1-2, 4-5 and 42-45** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. **12//170,942**. Although the conflicting claims are not

identical, they are not patentably distinct from each other because although the claimed limitations are not equally stated verbatim, the overall breadth of the limitations is equal. Therefore obviousness type Double Patenting rejection is applied.

4. **Claims 1-2, 4-5 and 42-45** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. **12//170,964** for the same reasons as stated in reference to Double Patenting rejection over copending application No. 12/170,942 above.

5. **Claims 1-2, 4-5 and 42-45** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. **12/170,975**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations although are worded as different entities perform the same function. The claimed "title" in the '975 application is congruent to the "third file" as stated in the parent ('799) application and similarly, combining the "first reproduction information, second reproduction information" is congruent to the limitation of "the second file" in the parent application.

6. **Claims 1-2, 4-5 and 42-45** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. **12//170,992** for the same reasons as stated in reference to Double Patenting rejection over copending application No. 12/170,975 above.

7. **Claims 1-2, 4-5 and 42-45** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending

Application No. **12/170,911** in view of Kato et al. (US 2002/0164152). Claims 1-2, 4-5 and 42-45 of this instant application teaches of all limitations as stated in copending Application no. 12/170,911 except for the limitation regarding "a third file comprising navigation data including at least one command, each command controlling reproduction of a corresponding reproduction information unit" and for the third file to be recorded separately.

In an analogous art, Kato et al. teaches a third file comprising navigation data including at least one command, each command controlling reproduction of a corresponding reproduction information unit (Paragraphs 375-383 teaches of mark information that is stored in either a Menu.thmb or Mark.thmb file. The mark information can be of a volume, playlist or clip type. Upon initial playback a thumbnail (representative picture) corresponding to a volume or a playlist can be displayed and operable for user selection (see paragraphs 160-162) These marks (stored in menu.thmb file (Fig. 78)) allows for the commands of playing a particular mark (be it volume, playlist, clip or for fast forward purposes as well))

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to record a third file as taught by Kato et al. into claim 1 of copending Application No. 12/170,911 so that the first and second file can be reproduced with the use of the third file by giving the user the ability to select a particular point, volume or playlist for playback.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

8. Applicant's arguments, see page 5-6 regarding the applied reference of Tiara et al., filed 12/7/2009, with respect to the rejection(s) of claim(s) 1-2, 4-5 and 42-45 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kato et al. based on a different interpretation necessitated by the present amendment. The new ground of rejection is made below.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

> The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

> Claims that recite nothing but the physical characteristics of a form or energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

> ... a signal does not fall within one of four statutory classes of 101.

> ... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claims 1-2 and 4-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Regarding claims 1-2 and 4-5, in the state of the art, transitory signals are commonplace as a medium for transmitting computer instruction and thus, in the absence of any evidence to the

contrary and give the broadest reasonable interpretation, the scope of a "computer readable medium" covers a signal per se.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claims 1-2, 4-5 and 42-45** are rejected under 35 U.S.C. 102(e) as being anticipated by Kato et al. (US 2002/0164152).

12. **Regarding claims 1 and 42,** Kato et al. teaches a data storage medium and an apparatus for recording/reproducing data on a storage medium, comprising:

a first file comprising at least one clip, each clip comprising audio visual stream data (Paragraph 226 teaches an AV stream file) and a timemap comprising information on reproduction time when the audio visual stream data is reproduced (Paragraphs 198-200 and 344 and 347 teaches of PTS information (PTS_EP_start) stored within CPI (which is part of the CLIPINF file (see Fig. 14))) and information on a reproduction position of the audio visual stream data corresponding to the reproduction time Paragraphs 198-200 and 344 and 347 teaches of address information (RSPN_EP_start) stored within CPI (which is part of the CLIPINF file (see Fig. 14)));

a second file comprising at least one reproduction information unit for reproducing audio visual stream data, each reproduction information unit comprising information indicating a reproduction interval of a corresponding clip (Fig. 29-30 and respective disclosure teaches of either 1) Real Playlists or 2) Virtual Playlists that includes within their syntax plurality of IN and OUT points for indicating a reproduction interval. The Real Playlist or the Virtual Playlist is stored in a separate file in Fig. 14); and

a third file comprising navigation data including at least one command, each command controlling reproduction of a corresponding reproduction information unit (Paragraphs 375-383 teaches of mark information that is stored in either a Menu.thmb or Mark.thmb file. The mark information can be of a volume, playlist or clip type. Upon initial playback a thumbnail (representative picture) corresponding to a volume or a playlist can be displayed and operable for user selection (see paragraphs 160-162) These marks (stored in menu.thmb file (Fig. 78)) allows for the commands of playing a particular mark (be it volume, playlist, clip or for fast forward purposes as well)), wherein the first file, the second file and the third file are recorded separately on the data storage medium (as discussed above, also see Fig. 14).

Regarding claims 2 and 43, as discussed above, the Clip AV stream includes audio and video data.

Regarding claims 4 and 44, as discussed above, the playlist file is recorded separately, logically and physically from the second layer in Figure 14.

Regarding claims 5 and 45, as discussed above and illustrated in Fig. 14.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GELEK TOPGYAL whose telephone number is (571)272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gelek Topgyal/
Examiner, Art Unit 2621

/JAMIE JO ATALA/
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